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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/638,241	08/14/2000	Bret A. Ferree	BAF-11802/29	9686
7590 05/20/2005			EXAMINER	
John G Posa Esq Gifford Krass Groh Sprinkle Anderson & Citkowski PC 280 N Old Woodward Ave Suite 400 Birmingham, MI 48009			HO, UYEN T	
			ART UNIT	PAPER NUMBER
			3731	
DATE MAILED: 05/20/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/638,241	FERREE, BRET A.	
	Examiner	Art Unit	
	(Jackie) Tan-Uyen T. Ho	3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed on 4/29/05 have been fully considered and are persuasive. The rejection of previous office action has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Bao et al. (6,224,630).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 12-19, 21 and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Bao et al. (6,224,630).

In regard to claim 12, Bao et al. disclose annular devices and methods for sealing an annular tear comprising a step of: inserting a device to an annular tear/opening/defect and occluding the tear/opening/defect by allowing the device to expand to a larger size (col. 4, lines 50-59; col. 7, line 45-59).

In regard to claim 13, Bao et al. disclose using a delivery cannula having a longitudinal moveable expulsion rod therein so that an annular device can be contained

Art Unit: 3731

in contracted form inside the distal portion of the cannula and expelled through the tip into the tear/opening/defect.

In regard to claims 14, 15, 21 and 22, Bao et al. disclose the annular devices comprising a porous material and being made from polymers, metallic and alloys material and the device can be formed of a plug or sheet-like or a cylindrical plug with mushroom, spool-like or anvil-like configuration at end portions in order to prevent migration of the plug (col. 7, line 45 to col. 8, line 65). Additional anchoring means in forms of polymeric meshes or tines, staples (with broadest reasonable interpretation contains spike) or suture (with broadest reasonable interpretation contains wire) for anchoring the annular device in place relative to the tear/opening/defect.

In regard to claim 16, Bao et al. disclose the annular device includes material that swell by hydration such device inherently will absorb liquid as following insertion of the annular device into the tear/opening/defect and the device absorbed liquid inherently solidify in order to afford securing to the tear/opening/defect.

In regard to claim 17, Bao et al. disclose the annular device includes an elastomer (col. 16, claim 27) or a hydrogel such as poly vinyl alcohol (col. 15, claim 6).

In regard to claim 18, Bao et al. method and device occludes the defect while inherently allowing compression and distraction of the disc with respect to normal spinal movement.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bao et al. (6,224,630). Bao et al. teach the annular device for hernia repair being self-expandable such as expandable when it is released from constraining means and the device being made from plastic, metal or alloy. Although, Bao et al. do not disclose the annular device being made from titanium, Titanium is well known metal material in the art for use to make self-expandable surgical device such as anchor, occluding implant or implant support and patch. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make Bao et al.'s device from titanium material in order to provide the device with self-expandable characteristic as well as biocompatible.

For supporting the well-known statement, examiner provides two references that disclose using titanium to make surgical patch or occluding implant: Brown 5,824,082; Ruiz 5,976,174.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to (Jackie) Tan-Uyen T. Ho whose telephone number is 571-272-4696. The examiner can normally be reached on MULTIFLEX Mon. to Sat..

Art Unit: 3731

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ANHTUAN NGUYEN can be reached on 571-272-4963. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



(Jackie) Tan-Uyen T. Ho
Patent Examiner
Art Unit 3731

May 17, 2005